

Attorney Docket No. O/99469 US

REMARKS

Upon entry of the above amendment claims 1, 3-11 and 13-16 will be pending in the instant application. Claim 13 has been withdrawn due to a restriction requirement. Applicants have amended the claims to remove the 7 α -alkyl substituents. Applicants reserve the right to file a Continuation Application directed to the 7 α -alkyl substituents. Applicants have not raised any issue of new matter.

Applicants recognize that the amendments filed October 13, 2003 were not entered into the record. Applicants respectfully request the entry of the above amendments and the following remarks into the record.

Priority

Applicants acknowledge that the Examiner has reported that SOME of the certified copies of the priority documents have been received in the January 15, 2002 Office Action. The July 11, 2003 Office Action does not indicate an acknowledgement for priority. Applicants respectfully request the Examiner to identify what copies are present in the file and what copies are not present.

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Issue Under 35 U.S.C. §103(a)

Claims 1, 3-6, 8-11 and 14-16 stand rejected under 35 U.S.C. §103(a) as allegedly being obvious over Bardin '834 (USP 5,342,834). Applicants respectfully submit that patentable distinction exist between the present invention and the cited prior art.

Distinctions Between the Present Invention and Bardin '834

Bardin '834 discloses similar compounds (7 α -methyl), whereas the claimed compounds are (C₂) alkyl. The Examiner asserts that column 7, lines 9-14 of Bardin '834 provides motivation to modify Bardin '834.

As discussed in previous responses, Bardin '834 discloses a method of providing androgen supplementation without inducing an abnormal weight gain in the prostrate. See column 1, lines 11-13. Bardin '834 only discloses intramuscular, subcutaneous or transdermal administration. See claim 8.

Bardin '834 fails to disclose the compounds of the present invention, because the 7 α -alkyl substituents are not present in this application. Bardin '834 fails to address the oral activity of the compounds.

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Applicants respectfully request withdrawal of the 35 U.S.C. §103(a) rejection.

Allowability

In the Office Action mailed January 29, 2003, the Examiner indicated that "[c]ompounds having 7-substituent other than alkyl are considered allowable." Applicants have amended the present claims to encompass compounds and pharmaceutical compositions that do not have a 7 α -alkyl substituent; therefore, the application should be in condition for allowance.

Applicants respectfully request the mailing of a Notice of Allowance.

Conclusion

Applicants submit that every issue raised by the outstanding Office Action has been addressed. Therefore, the present claims define patentable subject matter and are in condition for allowance.

Should the Examiner believe that a conference would be helpful in advancing the prosecution of this application, he is invited to telephone Applicants' Attorney at the number below.

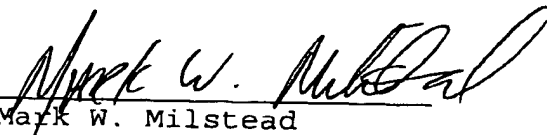
Pursuant to 37 C.F.R. §§1.17 and 1.136(a), Applicants respectfully petition for a one month extension of time for filing

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a response in connection with the present application and please charge the required fee of \$110 to Deposit Account No. 02-2334

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2334 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,


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